

Lee DeGross Appn. Number 10/081,579 Exam. Group/Art Unit 2655 Suppl Amnt contd.

REMARKS: Please add and delete the remarks in the **REMARKS-General** section of Amendment A as follows:

1. Page 38, 10th paragraph, delete the following sentence.

~~3. The word “relevent” is deleted to broaden the claim in concise language under § 112.~~

2. Page 39, 7th paragraph, add the word “relevant” as follows:

The applicant respectfully disagrees that MacMillan, in col. 3 regarding “print out is generated”, describes the **pop up digital spaces, various relevant images, and digital video** of claim 13.

3. Page 39, 9th paragraph, add the word “relevant” as follows:

Thus claim 13 recites the novel physical features of **pop up digital spaces, various relevant images, and digital video** that distinguishes over MacMillan in col. 3 of his invention.

4. Page 40, 1st paragraph, add the word “relevant” as follows:

1. Claim 13 is novel over MacMillan because his invention does not describe the **various relevant images** of the claim.

5. Page 40, 2nd paragraph, add the word “relevant” as follows:

Instead MacMillan describes only one line **of text** for each word in his invention. Thus the novel physical feature of various **relevant images** of claim 13 distinguishes over MacMillan.

6. Page 40, 5th paragraph, add the word “relevant” as follows:

3. Claim 13 recites **the novel structure** of pop up digital spaces that presents various **relevant images** including digital video when a cursor is placed over a word or phrase in a text.

7. Page 41, 3rd paragraph, add the word “relevant” as follows:

Novelty: Claim 13 is different from MacMillan and all previously known counterparts because the pop up digital spaces of the claim presents various relevant images that includes digital video is a novel method to learn about a word or phrase. Merely making a claim different may not appear to be an advantage per se, but it is usually a great advantage. This novel method of claim 13 did not exist as of the applicant’s filing date. The novelty result of claim 13 is very different than MacMillan because he fails to show the novelty result.

8. Page 41, 4th paragraph, add the word “relevant” twice as follows:

Social Benefit: Claim 13 provides a greater social benefit than MacMillan because the various relevant images of the claim such as digital video are a unique and helpful way to learn about a word or phrase. The various relevant images such as digital video are extremely useful for the purposes of learning, knowledge, and education. The social benefit result of claim 13 is very different than MacMillan. In fact MacMillan wrote, ““it is, of course, obvious that a great deal of information will be lost and that many inaccuracies and ambiguities will be created.” Thus MacMillan concedes that the very specific primary etymology of his invention on only one line of text for each word likely has a significantly smaller and limited social benefit.

9. Page 41, 5th paragraph, add the word “relevant” as follows:

Salability: Claim 13 is easier to sell and market than MacMillan because the various relevant images of the claim such as digital video provide substantially more interesting information. The salability result of claim 13 is very different than MacMillan because his primary etymology on only one line of text for each word is staid and not popular. In fact MacMillan wrote, “However, the average person seldom consults the dictionary for etymological information.” Thus MacMillan concedes his primary etymology is not popular, harder to sell and market, and likely has a limited salability result.

10. Page 42, 2nd paragraph, add the word “relevant” as follows:

Viewability: Claim 13 relates to eye use and presents colorful, enlivening, and more viewable images than MacMillan because of the various “relevant” images of the claim such as digital video. The viewability result of claim 13 is very different than MacMillan because his invention shows images in the text format of words on only one line. As mentioned MacMillan wrote, ““it is, of course, obvious that a great deal of information will be lost and that many inaccuracies and ambiguities will be created.” Thus MacMillan shows a limited viewability result.

11. Page 42, 3rd paragraph, add the word “relevant” as follows:

Market Size: Claim 13 has a potentially larger market size than MacMillan because the various relevant images of the claim such as digital video are a more interesting subject matter when learning about a word or phrase. As a result this appeals to a larger market than MacMillan. The market size result of claim 13 is very different than MacMillan because his primary etymology on only one line of text for each word is mundane, and not as interesting as a digital video. Thus MacMillan likely has a small, limited market size result.

12. Page 42, 3rd paragraph, add the word “relevant” as follows:

Potential Competition: The various images of claim 13 such as digital video is likely popular, cheap, and easy to manufacture that many imitators and copiers are likely to attempt to copy it or design around it, or try to break the patent as soon as it is brought out. The potential competition result of claim 13 is very different than MacMillan because his primary etymology on only one line of text is not popular, and is harder to manufacture with its numerous steps and parts. As mentioned MacMillan wrote, “However, the average person seldom consults the dictionary for etymological information.” Thus MacMillan likely has a very limited competition result.

13. Page 42, 4th paragraph, add the word “relevant” as follows:

Quality: Claim 13 produces a higher quality output than MacMillan because the various relevant images of the claim such as digital video provide richer, more interesting information. The higher quality result of claim 13 is very different than MacMillan because his only one line of text output shows substantially less information. As mentioned MacMillan wrote, ““it is, of course, obvious that a great deal of information will be lost and that many inaccuracies and ambiguities will be created.” Thus MacMillan concedes his invention shows poor quality results.

14. Page 42, 5th paragraph, add the word “relevant” as follows:

Excitement: Claim 13 is in an excitement category because the various relevant images such as digital video enlivens and perhaps galvanizes the learning experience of a word or phrase. For example, a digital video showing an exciting sports highlight for the phrase “squeeze bunt” augments the dictionary elements for the phrase. The excitement result of claim 13 is very different than MacMillan because his plain text result is not exciting. Also as mentioned MacMillan wrote, “However, the average person seldom consults the dictionary for etymological information.” Thus MacMillan implicitly concedes that his invention is not in an excitement category.

15. Page 43, 3rd paragraph, add the word “relevant” as follows:

New Use: Claim 13 has discovered a new use for the various relevant images such as digital video because such images are presented in pop up digital spaces with the dictionary elements from referred claim 11. The new use result of claim 13 is very different than MacMillan because he fails to show the new use.

16. Page 42, 4th paragraph, add the word “relevant” as follows:

Long Life Cycle: Claim 13 likely has a longer life cycle than MacMillan because the various relevant images of the claim such as digital video presented in pop up digital spaces can be made and sold for many years. The long life cycle result of claim 13 is very different than MacMillan because his invention heavily depends on a printer and a

supply of paper. Thus the invention of MacMillan may become obsolete and likely has a limited life cycle result.

17. Page 43, 6th paragraph, add the word “relevant” as follows:

Combination Products: Claim 13 is a combination product because the pop up digital spaces and the various relevant images such as digital video groove well together. The combination product result of claim 13 is very different than MacMillan because his primary etymology on only one line of text is combined with a printout.

18. Page 44, 2nd paragraph, add the word “relevant” as follows:

High Sales Anticipated: Claim 13 anticipates a high sales volume because the various relevant images presented in pop up digital spaces when a cursor is placed over a word or phrase is relatively simple, cheap, and easy to market. The potential high sales result of claim 13 is very different than MacMillan because his invention is relatively complex, more expensive, and harder to market with its numerous steps and parts. Thus MacMillan likely does not have a high sales result.

19. Page 44, 3rd paragraph, add the word “relevant” as follows:

Visibility of Invention in Final Product: Claim 13 is highly visible because the various relevant images such as digital video are easy to see from its rich information. This will be a distinct marketing advantage to entice buyers who love the new. The high visibility result of claim 13 is very different than MacMillan because his primary etymology on only one line of text for each word on a printout shows a significantly lower visibility result.

20. Page 44, 4th paragraph, add the word “relevant” twice as follows:

Youth Market: Young people have substantial discretionary income and tend to spend more in many product areas than the rest of the population. Claim 13 will appeal to young people because computers are popular with this market. The various relevant

images such as digital video of claim 13 are very useful for young people to learn about a word or phrase. The various relevant images of claim 13 are important for the purposes of learning, knowledge, and education. Claim 13 is valuable because higher education is often a priority of young people. Claim 13 likely will command more sales of the youth market than the staid, static primary etymology of MacMillan. As a result the large potential youth market result of claim 13 is very different than MacMillan and his likely small youth market.

21. Page 45, 3rd paragraph, add the word “relevant” as follows:

Different Combination: The combination of claim 13 had not been previously created as of the applicant’s filing date. The combination of claim 13 of pop up digital spaces and the various relevant images such as digital video is very different than the combination of MacMillan. MacMillan shows a combination of primary etymology on only one line of text and a printout. The only one line of text of MacMillan is so far different from the digital video of claim 13 that his invention must be regarded as different from that of claim 13.

22. Page 45, 4th paragraph, add the word “relevant” as follows:

Unexpected Results: The results achieved by claim 13 are new, unexpected, superior, disproportionate, unsuggested, unusual, critical and surprising over MacMillan. The various relevant images such as digital video of claim 13 provide a fast, convenient, and unique method to learn about a word or phrase. MacMillan does not show any images at all except for the text, much less a digital video. Thus MacMillan fails to show the unexpected results of claim 13.

23. Page 45, 5th paragraph, add the word “relevant” as follows:

Unrecognized Problem: The problem solved by claim 13 was never before even recognized. The various relevant images such as digital video solve the unrecognized problem of learning about a word or phrase presented in pop up digital spaces. The

solution produced by claim 13 did not exist as of the applicant's filing date. MacMillan fails to recognize the problem solved by claim 13 because he does not show any images except for the text, much less a digital video. The recognition of an unrecognized problem by claim 13 militates in favor of patentability.

24. Page 46, beginning on the 2nd paragraph, add the word "relevant" twice as follows:

Unsuggested Modification: MacMillan lacks any suggestion that his invention should be modified in the following manner required to meet claim 13.

The O.A. states "In regard to claim 3, MacMillan show a system and method for conveniently providing dictionary elements, wherein said pop up digital spaces can contain various relevant images and moving images that help said computer users such as photographs, illustrations, paintings, charts, diagrams, films, videos, digital video works, animation, claymation, stop action (print out is generated, col. 3)."

As mentioned claim 3 is canceled and replaced by new claim 13.

MacMillan at col. 3 does not describe and show the pop up digital spaces that present various relevant images such as digital video of claim 13. MacMillan at col. 3 also does not describe and show the function of claim 13 of when a cursor is placed over a word or phrase for the pop up digital spaces to appear.

Instead MacMillan, regarding printout is generated at col. 3, wrote 7 times about printouts although the phrase "is generated" was never written at col.3. The 7 printouts at col. 3 show the only one line of text for each inputted word. The printouts at col. 3 of MacMillan fail to describe and show the various relevant images of claim 13 such as digital video.

Therefore MacMillan, and his printouts at col. 3, lacks any suggestion that his invention should be modified in a manner required to meet claim 13.

25. Page 46, 9th paragraph, add the word "relevant" as follows:

Unappreciated Advantage: Up to now MacMillan and those skilled in the art never appreciated the advantages of claim 13, although it is inherent. The advantages of claim

13, of various relevant images such as digital video presented in pop up digital spaces, to learn about a word or phrase did not exist as of the applicant's filing date.

26. Page 46, 10th paragraph, add the word "relevant" twice as follows:

Poor Reference: MacMillan is a poor reference because his invention is vague, foreign to, and conflicts with claim 13. As mentioned MacMillan wrote, "it is, of course, obvious that a great deal of information will be lost and that many inaccuracies and ambiguities will be created." MacMillan, by his own description, concedes that his invention is vague. MacMillan is entirely foreign to claim 13 because he does not describe and show the various relevant images of the claim such as digital video. MacMillan conflicts with claim 13 because the various relevant images of the claim such as digital video are very different than his result of only one line of text for each word. The reference of MacMillan is therefore weak and should be construed narrowly.

27. Page 47, 2nd paragraph, add the word "relevant" as follows:

Lack of Implementation: If claim 13 were in fact obvious, because of its advantages MacMillan and those skilled in the art surely would have implemented it as of the applicant's filing date. The fact that MacMillan and those skilled in the art have not implemented the various relevant images such as digital video of claim 13, despite its great advantages, indicates that it is not obvious.

28. Page 47, 3rd paragraph, add the word "relevant" as follows:

Misunderstood Reference: MacMillan does not teach what the O.A. relies upon it as supposedly teaching because he fails to teach the various relevant images of claim 13, much less a digital video. The minor exception is his only one line of text results.

29. Page 47, 4th paragraph, add the word "relevant" as follows:

Contrarian Invention: Claim 13 is contrary to the teachings of MacMillan because the various relevant images presented in pop up digital spaces of the claim such as digital

video, goes against the grain of what he teaches. Rather MacMillan teaches obtaining the primary etymology on only one line of text for each word on a printout.

30. Page 47, 5th paragraph, add the word “relevant” as follows:

Strained Interpretation: The O.A. has made a strained interpretation of MacMillan that could be made only by hindsight because his invention clearly does not show the various relevant images at all of claim 13, much less a digital video.

31. Page 47, 6th paragraph, add the word “relevant” as follows:

Solved Different Problem: Claim 13 solves a different problem than MacMillan, and such different problem is recited in the claim. Claim 13 solves the problem of learning about a word or phrase by presenting various relevant images such as digital video in pop up digital spaces. MacMillan solves the very different problem of showing the primary etymology of each word on only one line of text on a printout.

32. Page 47, 7th paragraph, add the word “relevant” as follows:

No Convincing Reason: The O.A. has not presented a convincing line of reasoning as to why the subject matter of claim 13 as a whole, including its differences over MacMillan, would have been obvious. MacMillan clearly does not show the various relevant images of claim 13 such as digital video presented in pop up digital spaces.

33. Page 106, 5th paragraph, the word “relevant” as follows:

the claimed distinctions are of patentable merit under § 103 because of the new and unexpected results produced of dictionary elements such as definitions, or various relevant images such as digital video, are presented in pop up digital spaces when a cursor is placed over a word or phrase in a text.

34. Page 103, beginning after 3rd paragraph, delete the phrase “to 23” and replace it with “and 22” four times as follows:

The New Dependent Claims 21 [[to 23]] and 22 Are A Fortiori Patentable Over MacMillan

New dependent claims 21 [[to 23]] and 22 incorporate all the subject matter of new claim 11 and add additional subject matter which makes them a fortiori and independently patentable over MacMillan.

The reasons that new claims 21 [[to 23]] and 22 are novel over MacMillan include those from referred new claim 11 discussed in the above heading, "The Rejection of Claim 1, Now New Claim 11, On MacMillan Overcome Under § 102".

The new and unexpected results for new claims 21 [[to 23]] and 22 include those from referred new claim 11 discussed in the above headings "New Claim 11 Produces New and Unexpected Results and Hence Is Unobvious and Patentable Over MacMillan Under § 103" and "New Claim 11 is Unobvious Over MacMillan Under § 103 for the Following Additional Reasons:".

35. Page 104, beginning on 6th paragraph, delete the entire section as follows:

~~New Claim 23 additionally recites "The method of Claim 11 further including said using said computer, said utilizing said text displayed on said computer screen, said having said cursor present on said computer screen, said dictionary elements, said word or phrase, said pop up digital spaces, said whereby said dictionary elements for said word or phrase are presented in said pop up digital spaces when said cursor is placed over said word or phrase in said text, said dictionary elements includes a definition presented in said pop up digital spaces, said pop up digital spaces presents various images that includes digital video when said cursor is placed over said word or phrase in said text, said pop up digital spaces are menu driven and utilize the drag and selection methods of said cursor to select various choices in the menus, if said dictionary elements present more than one meaning of said word or phrase the intended contextual meaning of said word or phrase can be highlighted or otherwise distinguished, said dictionary elements presented in said pop up digital spaces that are from a sources that includes published works, said dictionary elements are to be used~~

~~judiciously, said pop-up digital spaces presents a plurality of said pop-up digital spaces, a language used in said pop-up digital spaces is different from the language used in said text, said language used in said pop-up digital spaces and said language used in said text can be a multitude of languages, said various images presented in said pop-up digital spaces that are from said sources that includes professional works, the computer machine that evolved to present said dictionary elements for said word or phrase in said pop-up digital spaces.”~~

~~Claim 23 recites novel physical features that distinguish over MacMillan because his invention does not describe each of the many elements of the claim.~~

~~Claim 23 produces new and unexpected results because it presents dictionary elements such as definitions for a word or phrase and digital video in pop-up digital spaces on a computer screen when a cursor is placed over the word or phrase in a text.~~

~~MacMillan does not show the definitions presented in pop-up digital spaces of claim 23, much less the digital video results. The results of claim 23 are very different than MacMillan because his invention instead shows the primary etymology on only one line of text for each word in the just one specific English language point of view on a printout. Thus claim 23 is unobvious over MacMillan.~~

36. Page 105, 5th and 6th paragraphs, delete the phrase “21, 22, and 23” and replace it with “21 and 22” three times, and delete the word “reconsideration” and replace it with “consideration” as follows:

From the reasons discussed, the applicant submits that new claims ~~21, 22, and 23~~ 21 and 22 are clearly not described and shown by MacMillan because of the facts that the claims (a) are novel under 35 U.S.C § 102, and (b) produces valuable new, unexpected, and different results and hence is unobvious and patentable over MacMillan under 35 U.S.C § 103. The applicant solicits ~~reconsideration~~ consideration of claims ~~21, 22, and 23~~ 21 and 22.

Accordingly the applicant submits that new dependent claims ~~21, 22, and 23~~ 21 and 22 are a fortiori patentable and should also be allowed.

37. Page 106, 1st paragraph, add the following remarks regarding new dependent claims 24 and 25 as follows:

The New Dependent Claims 24 and 25 Are A Fortiori Patentable Over MacMillan

New dependent claims 24 and 25 incorporate all the subject matter of new claim 11 and add additional subject matter which makes them a fortiori and independently patentable over MacMillan.

The reasons that new claims 24 and 25 are novel over MacMillan include those from referred new claim 11 discussed in the above heading, “The Rejection of Claim 1, Now New Claim 11, On MacMillan Overcome Under § 102”.

The new and unexpected results for new claims 24 and 25 include those from referred new claim 11 discussed in the above headings “New Claim 11 Produces New and Unexpected Results and Hence Is Unobvious and Patentable Over MacMillan Under § 103” and “New Claim 11 is Unobvious Over MacMillan Under § 103 for the Following Additional Reasons:”.

New Claim 24 additionally recites “The method of Claim 11 wherein said cursor includes a mouse click selection method.”

Claim 24 recites novel physical features that distinguish over MacMillan because his invention does not describe a mouse click selection method, much less the function of a cursor to be placed over a word or phrase in a text.

Claim 24 produces new and unexpected results of a mouse click selection method of a word or phrase in a text so that dictionary elements are presented in pop up digital spaces. MacMillan does not show these results of claim 24 as of the applicant’s filing date.

The results of claim 24 are very different than MacMillan because his invention instead shows pressing keys to bring up search macros and to input words into a search box to provide the very specific results of primary etymology on only one line of text for each word on printouts. Thus claim 24 is unobvious over MacMillan.

New Claim 25 additionally recites “The method of Claim 11 wherein said cursor includes a touchscreen selection method.”

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Claim 25 recites novel physical features that distinguish over MacMillan because his invention does not describe a touchscreen selection method.

Claim 25 produces new and unexpected results of a touchscreen selection method of a word or phrase in a text so that dictionary elements are presented in pop up digital spaces. MacMillan does not show these results of claim 25 as of the applicant's filing date.

The touchscreen selection method of claim 25 produces the unique results of greater salability, market size, excitement, long life cycle, related product addability, and a likely large youth market that are very different than MacMillan. Thus claim 25 is unobvious ver MacMillan.

From the reasons discussed, the applicant submits that new claims 24 and 25 are clearly not described and shown by MacMillan because of the facts that the claims (a) are novel under 35 U.S.C § 102, and (b) produces valuable new, unexpected, and different results and hence is unobvious and patentable over MacMillan under 35 U.S.C § 103. The applicant solicits consideration of claims 24 and 25.

Accordingly the applicant submits that new dependent claims 24 and 25 are a fortiori patentable and should also be allowed.

Accordingly, the applicant submits that the supplemental amendment corrects an informality of application 10/081,379. The supplemental amendment also corrects a few informalities in Amendment A and cancels a claim. The supplemental amendment amends a claim and adds 2 new dependent claims because each of the claims now recites omissions that were previously recited and described in application 10/081,379. The applicant respectfully solicits the corrections to place the application in condition for allowance.

Very respectfully,



Lee DeGross

Lee DeGross Appn. Number 10/081,579 Exam. Group/Art Unit 2655 Suppl Amnt contd.

400 Park Place, #1H

Fort Lee, NJ 07024

Tel. (201) 592-9999

Email: l_degross@msn.com

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Lee DeGross